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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,204	04/26/2000	DAVID REGAN	AND1P578	1516

29838 7590 10/05/2004

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EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/05/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,204

Applicant(s)

REGAN, DAVID

Examiner

James H Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to Amendment and Response to Final Office Action, dated 05/24/04 and to Request for Continued Examination Filed 07/15/04.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/24/04 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (U.S. Patent No. 6,202,052) in view of Hunkins et al. (hereinafter Hunkins, U.S. Patent No. 5,970,501).

In regard to independent Claim 1 (and similarly independent Claims 6, and 11), Miller teaches an "electronic intermediary" which searches for taxpayers tax data (Col. 4, lines 54-56; compare to Claim 1 (and similarly Claims 6, and 11), "... **accessing tax-**

related forms in a governmentally maintained forms database, wherein the tax-related forms include a plurality of fields"). Miller fails to disclose accessing a revenue services database, wherein the revenue services database stores tax return data in duplicate, in a first table on the revenue services database and in a second table on the revenue services database and extracting a portion of the tax return data from the revenue services database, such that the extracted tax return data is provided to a legacy processing system from the first table and the extracted tax return data is provided to a corporate information database from the second table. However, Hunkins teaches that a large organization typically has a number of systems with databases of information for different purposes. Typically these databases contain redundant (*duplicate*) data. A familiar example is the multiple *forms* a new employee is typically asked to fill out, for things such as payroll, *tax*, insurance, phone listing, and perhaps things such as parking permits. Although each *form* is for a different purpose, the person is asked for some of the same data such as name, address and Social Security number for each *form*. Each form eventually is input into a computer system, thus leading to the creation and maintenance of multiple databases, which have some common, redundant information (Col. 1, lines 19-30). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Miller and Hunkins because Hunkins contemplates storing data in duplicate both within a single database, and between multiple databases in an organization. The benefit would have been to maintain multiple copies of critical information. Continuing, Miller teaches that the electronic intermediary processes the tax data (Col. 6, lines 42-52; compare to

Claim 1 (and similarly Claims 6, and 11), “... **a code segment that completes the tax-related forms**”). Miller also teaches that portions of the tax data come from several existing (legacy) systems (see Fig. 2; compare with Claim 1 (and similarly Claims 6, and 11), “... **at least a portion of the plurality of fields are filled based on the tax return data, such that the tax return data on which field filling is based is extracted from both the legacy processing system and a succeeding processing system**”). Miller does not specifically teach a *succeeding processing system* as a source of data to populate the tax-related forms or a *revenue services database mirroring the succeeding processing system*. However, Hunkins teaches (referring to Fig. 3) a single change order 20 to administration, to change the employee name, only requires one update to a computer 50 having the centralized or common database 70 (a succeeding processing system) of the present invention. This computer then performs automatic update and synchronization of all four (or more, if others are present) external databases 11-14 (mirroring). This is shown in greater detail in Fig. 4, wherein the name fields of the various data files are exploded out to show the common data base contains all the names as indicated at 71, and information, as described below, to link this information to the corresponding name fields in the external data files, in a way that the computer can change and update them all (Col. 5, lines 5-20). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Miller and Hunkins because both deal with organizations that access multiple databases likely containing some duplicate data. Adding the teaching of Hunkins allows for incorporating a new system that consolidates the data in once place, yet allows for

updates to be passed along to legacy systems (actually, Miller suggests in Fig. 2 that the connections between the central and other database sites are 2-way allowing for the possibility of such interactions as taught by Hunkins). Continuing, Miller also teaches that the electronic intermediary electronically files the processed tax returns with the taxing authorities which, in the case of the U.S. Internal Revenue Service (IRS), will correspond to the appropriate federal tax return such as the Form 1040 or the Form 1040EZ (note both forms contain content and structure that are produced, maintained, and updated by the IRS) (Col. 6, lines 56-61; 62-64; compare to Claim 1 (and similarly Claims 6, and 11) “... **a code segment that submits the tax-related forms to a government entity, wherein the tax-related forms are formatted based on rules associated with the governmental entity**”).

In regard to dependent Claim 2 (and similarly dependent Claims 7, and 12), Miller teaches that the “electronic intermediary” receives data from the taxpayer’s brokerage firms, taxpayer’s charities, taxpayer’s other tax data providers, taxing authorities, taxpayer’s banks, taxpayer’s employers which can be stored by the electronic intermediary (Col. 5, lines 50-65; Fig. 2; compare to Claim 2 (and similarly Claims 7, and 12) “... **storing updates to the tax-related forms in the governmentally maintained forms database**”).

In regard to dependent Claim 3 (and similarly dependent Claims 8, and 13), Miller teaches that the electronic intermediary electronically files the tax returns with the taxing authorities (Col. 6, lines 62-64; compare to Claim 3 (and similarly Claims 8, and

13), ***“... submitting the completed tax-related forms to a processor utilizing a network for processing”***).

In regard to dependent Claim 4 (and similarly dependent Claims 9, and 14), Miller teaches that the electronic intermediary can receive processed data from any of the entities (see Fig. 2 compare to Claim 4 (and similarly Claims 9, and 14), ***“... the processed tax-related forms are received utilizing the network for storage in the governmentally maintained forms database”***).

In regard to dependent Claim 5 (and similarly dependent Claims 10, and 15), Miller teaches an electronic data network such as the Internet is used by the electronic intermediary (Col. 3, lines 60-65; Col. 4, lines 51-54; compare to Claim 5 (and similarly Claims 10, and 15) ***“... the network is the Internet”***).

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
09/30/04


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER